UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,127	08/21/2003	Krystof C. Zmudzinski	884.930US1	7122

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EXAMINER
WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
3621	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
	10/645,127	ZMUDZINSKI ET AL.
Office Action Summary	Examiner	Art Unit	
	Jalatee Worjloh	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 January 2004</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5,7-12 and 38-41</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5, 7-12, 38-41</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendments

1.   This Office Action is responsive to the amendment filed January 4, 2007, in which claims

1, 4, 5, 7, and 8 were amended and claim 6 canceled and claims 38-41 added. Therefore, claims

1-5, 7-12, and 38-41 are pending.

Response to Arguments

2.   Applicants arguments filed January 4, 2007 have been fully considered but they are not

persuasive.

3.   Applicants argue that Simelius does not disclose "enabling execution of an application or

a sharable device by executing the application on the master device and by allocating the

sharable license to the sharable device." Also, Applicants assert that the "execution of the

application on the child device" does not appear to require that the application be currently

executed on the master device, as in claim 1 of the instant application."

However, it is noted that the feature upon which Applicant relies upon (i.e. requirement

that the application be currently executed on the master device) is not recited in the rejected

claims. Although the claims are interpreted in light of the specification, limitations for the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057

(Fed. Cir. 1993).

Additionally, claim 1 recites "enabling execution of the application on a sharable device

by executing the application in the master device", which means that the sharable device

executes the application once it is executed on the master device not at the present time or when

the application is currently executed on the master device. Thus, Simelius teaches "enabling

execution of the application on a sharable device by executing the application on the master

device (see paragraph [0014] – enable the parent client to access the first digital content from the

content provider and paragraph [0035] – the first client accesses the second digital content using

the voucher) and by allocating the sharable license to the sharable device (see paragraph [0012] –

parent client communicates one or more fist child vouchers to one or more child clients).

4.   Claim 8 was amended and now recites "enabling execution of the application on a

sharable device by allocating the shareable license to the shareable device only for so long as the

application is being executed on the master device." Applicants state that in Simelius the

execution of the application on a sharable device may occur even while the application is not

being executed on the master device and directs the Examiner to paragraph [0030] of Simelius.

The Examiner agrees that paragraph [0030] of Simelius does allow the client to listen to

the media when the parent is not available. However, this is only one embodiment of Simelius.

Therefore, this particular embodiment should not be construed as limiting the scope of the

invention, but as merely providing illustration of some of the presently preferred embodiment of

the invention. Notice, another preferred embodiment of Simelius suggests that the execution of

the application on the shareable device (i.e. client device) is enabled by "allocating the sharable

license to the sharable device only for so long as the application is being executed on the master

device." Particularly, paragraph [0120] of Simelius teach the client device receiving media from

the parent through streaming technology and/or by multicast. Thus, it is known in the art that

when media is stream it is also being executed from the server that is providing the media.

5.   All other arguments have been considered but are moot in view of the new ground(s) of

rejection.

6.   Claims 1-12 have been examined.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

8.   Claims 1-3, 7 –10 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Publication No. 2005/0071278 to Simelius.

Referring to claim 1, Simelius discloses execution of an application (i.e. first digital

content) on a master device (i.e. parent client) by allocating a master license (i.e. parent voucher)

and at least one shareable license (i.e. child vouchers) to the master device (see paragraph [0027]

– the parent client act as a holder of the parent voucher as well as a child client using one or

more of the child vouchers), and enabling execution of an application (i.e. second digital content)

on a shareable device (i.e. client) by executing the application on the master device (paragraph

[0014] – enable the parent client to access the first digital content from the content provider and

[0035] – the first child client accesses the second digital content using the voucher) and by

allocating the shareable license to the shareable device (see paragraph [0012] – parent client

communicates one ore more first child vouchers to one or more child clients). See paragraph

[0120]. As for terminating execution of the application on the shareable device after failing to

receive a response verifying current execution of the application on the master device, this is an

inherent step. That is, Simelius teaches streaming digital content from parent to client. It is

known in the art that when content/media is streamed, when the streaming server stops or is

interrupted the client or receiver will also terminate. Throughout the streaming process, the

receiving server and/or receiver checks if the streaming server is sending data.

Referring to claim 2, Simelius discloses allocating a plurality of shareable licensees

including the shareable license to the master device (see paragraph [0027] – the parent client act

as a holder of the parent voucher as well as a child client using one or more of the child

vouchers).

Referring to claim 3, Simelius discloses allocating the plurality of shareable licenses to a

corresponding plurality of shareable device (see paragraph [0012] – parent client communicates

one ore more first child vouchers to one or more child clients).

Referring to claim 7, Simelius discloses discovering the existence of the master device

and the application by the shareable device and receiving the second application by the shareable

device (see claim 1 above).

Referring to claim 8, Simelius discloses enabling execution of an application (i.e. digital

content) on a master device (i.e. parent client) by allocating a master license (i.e. parent voucher)

and at least one shareable license (i.e. child vouchers) to the master device (see paragraph [0027]

– the parent client act as a holder of the parent voucher as well as a child client using one or

more of the child vouchers). As for the step of enabling execution of the application (i.e. digital

content) on a sharable device by allocating the shareable license to the shareable device only for

so long as the application is being executed on the master device, this is an inherent step (see

paragraphs [0120] & [0121]). Simelius teaches streaming digital content from parent to client.

It is known in the art that when content/media is streamed, when the streaming server stops or is interrupted the client or receiver will also terminate. Throughout the streaming process, the receiving server and/or receiver checks if the streaming server is sending data; therefore, the shareable device will receive the license "only for so long as the application is being executed on the master device").

Referring to claim 9, Simelius disclose storing a master license code (i.e. content key) associated with master license in the master device (see paragraph [0125] & claim 21) and storing a shareable license code (i.e. content key) associated with the shareable license in the shareable device (see paragraph [0028] & claim 21).

Referring to claim 10, Simelius discloses augmenting the application to include an application code (i.e. content key) to check against a master license code stored in the master device (see paragraph [0014]).

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simelius as applied to claim 1 above, and further in view of US Publication No. 2002/0138441 to Lopatic.

Referring to claim 4, Simelius discloses the master device and an application (see claim 1

above). Simelius does not expressly disclose receiving a query at the master device to determine

current execution of the application. Lopatic discloses receiving a query at the master device to

determine current execution of the application (see paragraph [0018] – the execution of each

individualized software product is monitored and paragraph [0167] – the license server receives

a request including identification information to run the software product and searches for a

license matching the identification information). At the time the invention was made, it would

have been obvious to a person of ordinary skill in the art to modify the method disclose by

Simelius to include the step of receiving a query at the master device to determine current

execution of the application. One of ordinary skill in the art would have been motivated to do

this because it controls the transfer of licenses (see Lopatic paragraph [0018]).

11.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simelius as

applied to claim 1 above, and further in view of US Publication No. 2005/0102240 to Misra et al.

        Simelius discloses a shareable device and a first application (see claim 1 above).

Simelius does not expressly disclose receiving a response at the shareable device to verify the

current execution of the first application. Misra et al. discloses receiving a response (i.e. the

challenge) at the sharable device to verify the current execution of the first application (see

paragraph [0108] –the client requests a license; in response, the license server initiates a client

challenge to determine who the client is). At the time the invention was made, it would have

been obvious to a person of ordinary skill in the art to modify the method disclose to include the

step of receiving a response at the shareable device to verify the current execution of the first

application. One of ordinary skill in the art would have been motivated to do this because it determines who the client is and what platform it is running (see paragraph [0108] of Misra et al.).

12.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simelius as applied to claim 8 above, and further in view of US Publication No. 2004/0039916 to Aldis et al.

Simelius discloses shareable device and master device (see claim 8 above). Simelius does not expressly disclose receiving an option to upgrade the shareable device to operate as a second master device. Aldis et al. disclose receiving an option to upgrade the shareable device to operate as a second master device (see paragraph [0147] - Aldis et al. system allows client's to update their licenses for server-type products; since, this option is available can is suggested that a option to upgrade may be received). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Simelius reference to include the step of receiving an option to upgrade the shareable device to operate as a second master device. One of ordinary skill in the art would have been motivated to do this because it provides more flexibility to the clients.

13.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simelius as applied to claim 8 above, and further in view of Lopatic.

Referring to claim 12, Simelius discloses execution of an application on the shareable device (see claim 8 above). Simelius does not expressly disclose terminating the execution of the application on the shareable device by revoking the sharable license. Lopatic discloses terminating the execution of the application on the shareable device by revoking the sharable

license (see paragraph [0032] – Lopatic teaches continuing an execution of the individual

download copy if a permission to run is obtained and aborting the execution otherwise and claim

6 –the license has an expiration date that indicates a date on which the software license will

expire) modify the method disclose by Simelius to include the step of terminating the execution

of the second application on the shareable device after failing to receive a response verifying

current execution of the first application on the master device. One of ordinary skill in the art

would have been motivated to do this because it protects the rights of the software supplier and

control the transfer of licenses (see paragraphs [0017] &[0018] of Lopatic).

14.   Claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simelius.

Simelius discloses enabling execution of an application on a master device; the

application comprises digital content (see paragraphs [00120] &[0110]). Simelius does not

expressly disclose the application is a game or multi-player game. However, these differences

are only found in the nonfunctional descriptive material and are not functionally involved in the

steps recited. The enabling execution of the application step would be performed the same

regardless of the data. Thus this descriptive material will not distinguish the claimed invention

from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ

401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the

invention was made to enable execution of an application on a master device, where the

application comprises any type of data because the data does not functionally relate to the steps

in the method claimed.

Conclusion

15.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The

examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300 for Regular/After

Final Actions and 571-273-6714 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jalatee Worjloh
Primary Examiner
Art Unit 3621

March 19, 2007